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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER, and WILL GARDENSWARTZ

Appeal 2009-009673
Application 09/505,632
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appeal 2009-009673
Application 09/505,632

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3) (2008) of the Decision of October 30, 2009.

- Our Decision affirmed the Examiner's rejections of: claims 24, 27-29, 36, 39, 40, 41, 48, and 49 under 35 U.S.C. § 103(a) as unpatentable over Jovicic; claims 25, 26, 30, 37, 38, and 42 under 35 U.S.C. § 103(a) as unpatentable over Jovicic and Perkowski; claims 31 and 43 under 35 U.S.C. § 103(a) as unpatentable over Jovicic, Perkowski, and Smolen; claims 50 and 51 under 35 U.S.C. § 102(e) as anticipated by Jovicic;
- Our Decision reversed the Examiner's rejection of: claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph for insufficient antecedent basis.
- Our Decision (FF 5) found that Jovicic discloses an Internet Coupon Server that responds directly to a consumer's requests for a coupon, stating, "During an on-line connection between an Internet node and the Internet Coupon Server, the Internet coupon server accepts coupon selection from a user, and then transmits the unique Internet coupon back to the user's printing device or user's electronic mail storage device." (Col. 3 ll. 30-34).
- Our Decision found that: ... even reading claim 24 to require the remote Web site and the Web site of said manufacturer be separated by the Internet, we do not find this to be a patentably

distinct feature. This is because both implementations are within the level of skill of the ordinary artisan, because centralized and distributed computer implementations are old and well-known, as is operating two web sites on one server. Further, since different modules of computer code are commonly used to do different elements of work, having code modules operate within one server with local communication between them, or, alternatively, having the code modules operate in distributed web sites with remote inter-process communications between them, does not alter the function collectively performed by the several modules. *See, In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). (“it was proper for the Board to construe “user computer” to encompass the [multi-user] mainframes and [distributed, single-user] minicomputers of the cited prior art.”) (Decision 8).

1. Appellants assert our interpretation of the claim limitation, *in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer*, constitutes legal error.

In support of this assertion, Appellants point a preceding phrase¹ in claim 24 to impute that transmitting from the remote web site to the manufacturer's web site must occur over the Internet.

We do not see any requirement in the claims to impute the Internet limitation into the phrase *transmitting from said remote Web site to said Web site of said manufacturer* (hereafter the latter phrase). If Appellants sought to overcome the prior art based on this feature, then they should have added this limitation into the phrase to explicitly recite that *transmitting from said remote Web site to said Web site of said manufacturer* occurs over the Internet-which did not occur.

Our reasons for differentiating between the two phrases and hence two different transmission modes outweigh Appellants' general assertion of error. First, in the former phrase (see note 1) the direction of communication moves from the Web site of said manufacturer to the remote Web site, whereas in the latter, the direction of communication moves from remote Web site to said Web site of said manufacturer. Second, the types of messaging transmitted in the former phrase is region data whereas in the latter phrase the remote Web site transfers at least one manufacturer incentive and at least one name and address of a retailer.

We are entitled to read the claims in their "broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367,

¹ The previous phrase recites "in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;"

1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). We interpret the phrase *in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer* not to include the Internet requirement of the prior phrase because reasonable there are other modes through which a website can communicate and to assume that the messages will be routed in the same manner that they are received is outside the purview of our jurisdiction. This interpretation is reasonable because two computers can have multiple communications paths between them simultaneously, such as for example: two routes on different networks, an internal and external network, or a network and a point-to-point connection. Thus, a message could come in one connection, such as via an external network over the Internet, and go back over a different network, such as a point-to-point connection. Additionally, if two web servers are running on one computer in two separate software instances, they can communicate with each other using process-to-process communication, without using any communication path external to the computer running both instances of software.

2. Appellants' next argument alleges error in our decision because in the Appellants' view, the Decision follows the Examiner's finding that the "the ICN correspond to both claim 24's 'Web site of a manufacturer' and 'remote web site'. (Request 2). However, Appellants' arguments are not

persuasive because the claim only requires two different web sites, which distinction is based on software differences, and not on the location of these websites relative to each other. As such, we find no error because two different web sites may run on one computer as two separate software instances.

Moreover, Appellants did not raise this issue before, and now on reconsideration, find it necessary to argue it on rehearing. The Appellants were given a fair opportunity to respond to the Examiner's rejection of the actually recited limitation, but instead chose not to raise this issue. At best, Appellants' Brief was directed only to repeating excerpts of claim 24 juxtaposed with statements that Jovicic's notification center 134 and server 124² do not meet the cited limitations. Since the Appellant has had a fair opportunity to respond to the Examiner's rejection, we hold the argument waived.

3. In response to the alternative basis offered in our Decision for affirming the Examiner's rejection of claim 24 based on an obviousness rationale, (Decision, page 8, ll. 1-15), Appellants argue that "... appellant notes that this is not a basis for rejection raised by the examiner in the Examiner's Answer. It is also not a basis of rejection that could reasonably have been anticipated by the appellant for the reasons noted below.

² Appellants' strongest argument was: Certainly nothing relating to transmission from notification center 134 of "at least one manufacturer incentive and at least one name and address of a retailer" and certainly nothing relating to transmission to "said Web site of said manufacturer" or even to Jovicic's coupon server 124. (Appeal Br.12).

Therefore, the appellant has not had a ‘fair opportunity to react to the thrust of the rejection’”. (Request, 3).

We will grant Appellants’ request to allow Appellants an opportunity to respond as our rationale here lies at the nub of this appeal. We note that we make this grant not based on any error of our own, but only to the extent that this portion of our Decision, (page 8, ll. 1-15), used a rationale which differed from that applied by the Examiner.

For the reasons above, we are not convinced that Appellants have shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier decision. Accordingly, Appellants’ request for rehearing insofar as Appellants seek an establishment error in the Decision of the Board is denied.

CONCLUSIONS OF LAW

We conclude:

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over the prior art has not been shown to have been erroneous. Because in so affirming we used a different rationale than that articulated by the Examiner, we grant the request for rehearing to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

Appeal 2009-009673
Application 09/505,632

REHEARING GRANTED AS TO DEMONINATING A NEW GROUND
UNDER 37 CFR 41.50(b)

MP